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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,344	10/29/1999	MICHAEL R. O'BRIEN	LOT9-99-0001	8551

21127 7590 07/14/2005

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BOSTON, MA 02109

EXAMINER
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FIELDS, COURTNEY D

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/431,344

Applicant(s)

O'BRIEN ET AL.

Examiner

Courtney D. Fields

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-20 are pending.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7-12 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 9, lines 4-21, the medium is not limited to tangible embodiments, instead being defined as intangible embodiments (e.g., client software subroutines - standard mail routine, processing routine). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 13-18 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 11, lines 5-24, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., diskette, CD-ROM) and intangible embodiments (e.g., optical, microwave, infrared or other transmission techniques). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 19-20 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 11, lines 5-24, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g.,

diskette, CD-ROM) and intangible embodiments (e.g., data signal embodied in a carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

### ***Claim Objections***

2. Claims 13-18 are objected to because of the following informalities: Changing "computer usable media" to --computer readable media--would limit the claims to tangible embodiments consistent with page 11 of the specification. Appropriate correction is required.

### ***Response to Arguments***

3. Applicant's arguments, see page 8, filed 29 April 2005, with respect to claims 1-20 have been fully considered and are persuasive. The 103 rejection of claims 1-20 has been withdrawn.

4. Applicant argues that at one point in time the Office allowed several patents with data signals embodied in a carrier wave and Applicant provided those listed patents. Applicant further states the PTO worked on the theory that if the computer program product claims are allowable, why should the nature of the medium make any difference?

The Examiner contends the PTO did at one point in time consider computer program product claims that stated a signal on a carrier wave or similar language was at that time deemed allowable. However, the PTO after reconsideration has determined that the earlier interpretation of a computer program product claim with a signal on a carrier

wave was incorrect. Therefore, the Office maintains its position with regards to claims 19-20.

### ***Allowable Subject Matter***

5. Claims 1-6 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: The present invention is directed towards a method and apparatus for encrypting electronic messages composed using abbreviated address books. The encryption flag is used to indicate the electronic message is not encrypted. The closest prior art Paladin System and RFC-822 discloses an offline system for composing email using an encryption field to identify that the associated message is encrypted, either singularly or in combination, fail to anticipate or render the above underlined limitations obvious.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clark (US Patent No. 5,815,577) discloses a method and apparatus for securely encrypting data in conjunction with a personal computer. Floyd et al. (Pub No. 2002/0161709) discloses a server-side commerce for deliver-then-pay content delivery. Gressel et al. (US Patent No. 6,609,114) discloses a system for safe collection of payment including electronic payment receipt generators having electronic purses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-

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272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdf

July 7, 2005



MATTHEW SMITHERS  
PRIMARY EXAMINER  
Art Unit 2137